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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,972	08/09/2001	Giancarlo Bisazza	07881.0011	3149

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Finnegan, Henderson, Farabow
Garrett & Dunner, LLP
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

HAWKINS, CHERYL N

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,972

Applicant(s)

BISAZZA ET AL.

Examiner

Cheryl N Hawkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-23, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-14, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the claims have been amended such that the method cannot be practiced by another materially different apparatus or by hand. Albeit amended Claim 1 is directed to a device for producing panels of mosaic tesserae, this limitation is considered to be an intended use for the claimed apparatus. Therefore, the Examiner maintains that the apparatus as claimed can be used to practice another and materially different process such as a process in which a protective sheet material is fed and applied to a metal substrate.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 24 and 25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is unclear as to how Claims 24 and 25, which recite the application of a transparent supporting sheet arranged on the visible face of a panel of glass mosaic, provide additional structural limitations for further limiting the apparatus of Claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 3, 5, 6, 7, 10, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeier (US 3,899,385) in view of Heitmann (US 3,955,481), Miyake (US 4,743,325), and Ernst et al. (US 3,868,292). Brinkmeier discloses an apparatus (Figure 1) which applies a sheet (cutoff label Z) on a visible face of an advancing article (bags S) which includes feeding means (vacuum drum 1) and application means (applying roller 5) for applying the sheet over the article, the application means including cutting means (cross cutter 3 and 4) to cut to size a segment of the sheet and suction drum rotating means (applying roller 5, shaft 7, vacuum bores 22 and 23, axial manifold bores 25 and 26) to temporarily retain, on an outer cylindrical surface, the segment of sheet and to release the segment onto the article. It is noted that it would have been readily apparent to one of ordinary skill in the art at the time of the invention to effect cutting the sheet material to a size such that the cut sheet corresponds to the advancing article.

As to Claim 1, Brinkmeier is silent as to the feeding means having a reel member configured to store and continuously dispense the sheet material. It is well known and conventional in the sheet material apparatus art, as disclosed by Heitmann (Figure 1, supply roller 1) and Miyake (Figure 3, supply roll 7), to provide feeding means which include a reel member configured to store and continuously dispense the sheet material. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the sheet material of Brinkmeier on a conventionally known reel member to store and continuously dispense the sheet material to the vacuum drum and applying roller for cutting and applying the sheet material onto an advancing article.

As to Claims 1, 6, and 7, Brinkmeier discloses mechanical means for arranged inside the drum for retaining the sheet after cutting and releases the sheet in correspondence with the advancing article (column 4, line 65 through column 5, line 25; column 6, line 4-9), but is silent as to means for interrupting the suction to release the sheet. It is well known and conventional in the sheet material

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handling apparatus art, as disclosed by Ernst et al. (column 3, lines 31-39), to provide means for interrupting the communication of the vacuum source to release a cut sheet so that it can be transferred by pressure to an advancing article. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the application suction drum of Brinkmeier to include means for interrupting the suction force to facilitate the release and application of the cut sheet onto the advancing article.

As to Claim 2, Brinkmeier discloses an apparatus in which the cutting means are able to act on the sheet when it is held on the outer surface of the suction drum means (Figure 1, cross cutter 3 and 4, applying roller 5).

As to Claims 3 and 25, Brinkmeier discloses an apparatus in which the sheet has a face equipped with gluing means and is able to wind on the suction drum means with its face without gluing means and for an angle such as to invert the direction of feed and present its face equipped with gluing means facing towards the article (Figure 1, label Z; column 5, line 35 through column 6, line 9).

As to Claim 5, Brinkmeier discloses an apparatus (Figure 1) in which the suction drum means (applying roller 5) includes a hollow drum equipped inside with means able to create a depression (column 5, lines 12-25) and with a plurality of holes (vacuum bores 22 and 23) on its cylindrical outer surface.

As to Claim 10, Brinkmeier discloses an apparatus (Figure 1) in which the sheet (cutoff label Z) is applied on the visible face of the article (bags S).

As to Claims 24 and 25, it is noted that the apparatus disclosed by Brinkmeier would be capable of providing a panel of glass mosaic with a transparent supporting sheet arranged on the visible face of the mosaic tesserae.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeier (US 3,899,385) as applied to claim 1 above, and further in view of Ahr (US 5,837,087). Brinkmeier does not disclose an apparatus including a pressure roller arranged downstream of the suction drum means. It is

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well known and conventional in the sheet material handling apparatus art, as disclosed by Ahr (Figure 1, pressure rollers 77), to use pressure rollers arranged downstream of application means to press the cut sheet onto the article thereby providing a firmer bond. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Brinkmeier to include a pressure roller arranged downstream of the suction drum means as suggested by Ahr to press the cut sheet onto the article thereby providing a firm bond.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeier (US 3,899,385) as applied to claim 3 above, and further in view of Heuser et al. (US 3,698,296), Talalay (US 4,504,336), and Du Fresne (US 2,931,751). Brinkmeier does not disclose an apparatus which includes means to deliver steam or nebulized water to reactivate glue on the sheet. It is well known and conventional in the labeling apparatus art, as disclosed by Heuser et al. (column 8, lines 59-66), that pressure-sensitive adhesive, solvent-activated adhesive, thermal-activated adhesives, and water-activated adhesives are often functionally equivalent. Talalay discloses a tab applying apparatus which includes an adhesive activator such as a hot water spray or a steam jet (column 14, lines 41-45). Du Fresne discloses a method for sealing a sheet material onto the surface of a tile which includes spray means for applying a bonding agent (Figure 2, sprayers 21). When utilizing the apparatus of Brinkmeier to apply sheet segments containing water-activated glue, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Brinkmeier to include means for delivering a steam or nebulized water jet against the surface as suggested by Talalay and Du Fresne to reactivate the glue on the sheet for bonding.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeier (US 3,899,385) as applied to claim 1 above, and further in view of Lindstrom et al. (US 4,321,103). Brinkmeier does not disclose an apparatus which includes alternate lifting and lowering means for the

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suction drum. Lindstrom et al. discloses a labeling apparatus which includes means for alternately lifting and lowering the label applying roller in synchronism with the passage of articles thereunder (column 5, lines 35-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the suction drum means of Brinkmeier to be equipped with means for alternately lifting and lowering the drum as suggested by Lindstrom et al. to allow for application of the cut sheet segments to be synchronized with the passage of articles underneath the suction drum.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeier (US 3899,385) as applied to claim 3 above, and further in view of Jue (US 4,432,830). Brinkmeier does not disclose the sheet material as having a two layers and a winding roller for detaching the second layer from the first layer which contains the adhesive. It is well known and conventional in the labeling apparatus art, as disclosed by Jue (Figures 4 and 5, take-up reel 12), to provide adhesively coated labels with a backing strip to protect the adhesive layer until the time of application and to provide the labeling apparatus with a take-up roller to remove the backing strip prior to the application of the labels. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Brinkmeier to provide adhesively coated labels with a backing strip to protect the adhesive layer until the time of application and to provide the labeling apparatus with a take-up roller as suggested by Jue to remove the backing strip prior to the application of the labels.

9. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeier (US 3,899,385) as applied to claim 1 above, and further in view of Miyajima et al. (US 6,321,813), Farfaglia et al. (US 3,847,540), and Sbrana (US 5,972,151). Brinkmeier does not disclose means for heating the article prior to applying the sheet. It is well known and conventional in the bonding apparatus art, as disclosed by Miyajima et al. (column 3, lines 27-29; column 4, lines 33-37), Farfaglia et al. (Figure 3), Sbrana (Figure 2), to heat a substrate with either a flow of hot air or a radiating heating device to facilitate

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bonding. It is well known and conventional in the labeling apparatus art, as disclosed by Heuser et al. (column 8, lines 59-66), that pressure-sensitive adhesive, solvent-activated adhesive, thermal-activated adhesives, and water-activated adhesives are often functionally equivalent. When utilizing the apparatus of Brinkmeier to apply sheet segments containing thermally-activated glue, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Brinkmeier to include means for heating the article prior to applying the sheet to reactivate the glue on the sheet thereby effecting bonding.

Response to Arguments

10. In response to the applicant's arguments that amended Claims 24 and 25, which are dependent upon Claim 1, were withdrawn improperly, the Examiner agrees and has included Claims 24 and 25 in the rejection rendered herein.

In response to applicant's argument that Brinkmeier discloses a labeling apparatus while the device recited in Claim 1 is directed to a device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to the applicant's arguments that the reference of Brinkmeier fails to teach or suggest a device which includes feeding means having a reel member configured to store and continuously dispense sheet material and application means for applying the sheet over an article, the arguments have been considered but are moot in view of the new ground(s) of rejection.

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In response to the applicant's arguments that the problems associated with production of panels of mosaic tesserae are quite different from those associated with labeling bags, the Examiner notes that the applicant has not provided the nexus between that assertion and the claimed invention. The Examiner maintains that the references as combined meet the limitations of present claims.

In response to the applicant's arguments that the references fail to teach or suggest a device including suction drum rotating means which retains a segment of sheet material by a suction force and releases the segment of sheet onto an article by temporarily ceasing the suction force, the Examiner disagrees. The reference of Brinkmeier is silent as to means for interrupting the suction to release the sheet material. However the reference of Ernst et al. (see column 4, lines 65 through column 5, lines 25; column 6, lines 4-9) was provided to disclose that it is well known and conventional in the sheet material handling apparatus art to provide means for interrupting the communication of a vacuum source to an application roller to effect the release a cut sheet so that it can be transferred by pressure to an article. The Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the application suction drum of Brinkmeier to include means for interrupting the suction force to facilitate the release and application of the cut sheet onto an advancing article.

In response to applicant's argument that the references of Brinkmeier and Ahr are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Examiner asserts the references of Brinkmeier and Ahr are in the field of the applicant's endeavor, which is the feeding, cutting, and adhesive bonding of a sheet material onto an advancing article.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

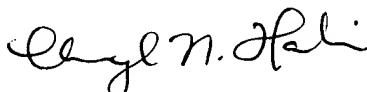
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N. Hawkins whose telephone number is (703) 306-0941. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

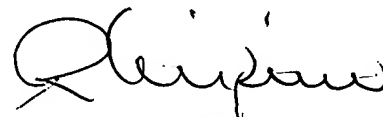
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where the application or proceeding is assigned is (703) 872-9310 for regular communications or (703) 872-9311 for After-Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

Cheryl N. Hawkins



August 25, 2003



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700